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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,230	04/19/1999	CHRISTOPHER EWING	3175.01A	6950

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EXAMINER
DIXON, THOMAS A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/295,230	EWING, CHRISTOPHER	
	Examiner	Art Unit	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10,11,13,14,16-20,26-29 and 33* is/are rejected.

7)☒ Claim(s) *9,12,15,21-25 and 30-32* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *15* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Argument's / Amendment

1. Applicant's remarks regarding public use/sale and applicant's business relationships are appreciated as making the record clear regarding inventorship, the rejections of the previous office action are withdrawn.

2. Applicant's arguments with regard to VanName are convincing, the rejections of the previous office action are withdrawn.

3. It is noted that applicant's assertion that the problem to be solved, or motivation must be in the reference is incorrect. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. Applicant's requirement for a reference to support the Official Notice is not seen to be a proper challenge, no argument as to the invalidity of the Official Notice is present in the remarks. Further, Official Notice regarding Privacy statutes seen to be applicant's burden to refute.

6. IDS, filed 30 December 2002 has been considered. The following art is cited as disclosing purchasing systems, but do not disclose the claimed invention:

LeRoy et al (5,970,474) and Montulli (5,826,242).

7. Regarding, patent application publication 2002/0178089 to (Bezos et al), submitted in applicant's IDS, filed 30 December 2002, which is not valid prior art because it was published after the application date of the instant application.

However, Bezos et al claims priority to applications 09/151,617, filed 09/11/1998, 09/046,503, filed 04/23/1998 and 08/928,951, filed 09/12/1997, now patent 5,960, 411 (a copy of which is enclosed) the gifting portion of the application does not appear in the '411 patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-4, 10, 19, 29, 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al.

As per Claims 1, 19.
Bezos et al discloses:
receiving a request over the internet from a first party for a gift to be sent to a second party, figure 8, paragraphs (0004)-(0005) and (0025)-(0026);
obtaining over the internet from said first party a pseudonym of said second party, see paragraph (0016) lines 1-16;
securing over the internet a non-pseudonymous name and address associated with the second party's pseudonym, see paragraph (0016), lines 16-24;
producing computer output enabling said gift to be sent to said second party while said non-pseudonymous name is not revealed to said first party, see figure 8, paragraphs (0004)-(0005) and (0025)-(0026).

As per Claim 2.
Bezos et al further discloses issuing an order that said gift be sent to said second party's non-pseudonymous name and address, see paragraph (0016) lines 1-16.

As per Claim 3.
Bezos et al further discloses looking up said non-pseudonymous name and address in a database, see paragraph (0016) lines 16-24.

As per Claim 4.
Bezos et al further discloses contacting said second party and requesting revelation of said second party's non-pseudonymous name and address, see paragraph (0016), lines 26-34.

As per Claim 10.
Bezos et al further discloses a third party, see paragraph (0026).

As per Claim 19.
Bezos et al discloses:
a web site, operably connected to said computers, enabling said first party to identify send said gift to said second party by a pseudonym of said second party without said web site revealing a non-pseudonymous name to said first party, see page 1, paragraph (0004).

As per Claim 29.
Bezos et al further discloses the second party identity maintained in confidentiality, see page 4 paragraph (0026).

As per Claim 33.

Bezos et al further discloses a web site, see page 1 paragraph (0003).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 5, 6, 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos et al in view of Baron et al (5,809,481).

As per Claim 5.

Bezos et al discloses the limitations of Claim 1.

Bezos et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Bezos et al does not disclose storing said second parties preference to opt out.

Baron et al ('481) teaches storing preferences in a database in association with said second party's pseudonym or name and address, see column 7, lines 22-47 for the benefit of collecting registration information from a user.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out, at the time of registration for the benefit of collecting privacy information from a customer.

As per Claim 6.

Bezos et al in view of Baron et al ('481) discloses all the limitations of claim 5.

Bezos et al further discloses registered shoppers and known systems which perform database lookups, see figure 2 (206), but does not disclose stored preferences.

Baron et al ('481) teaches checking said second party's stored preferences, see column 9, lines 8-18 and column 7, line 22 – column 8, line 32 for the benefit of management record keeping.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to perform a database lookup of the second party's information to ease the keying in of registration information and increase customer goodwill.

As per Claim 7.

Bezos et al in view of Baron et al ('481) discloses all the limitations of claim 5.
Bezos et al further discloses registered shoppers, see figure 2 (206) and known systems which perform database lookups, see paragraph (0016) lines16-24 and sending a gift to a mailing address, see paragraph (0018).

As per Claim 8.
Bezos et al further discloses registered shoppers, see figure 2 (206) and known systems which perform database lookups, see paragraph (0016).
Bezos et al does not disclose preference to "opt out" of gift receipt.
Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out, at the time of registration for the benefit of collecting privacy information from a customer.

10. Claims 13-14, 16-18, 20 are rejected under 35 U.S.C. 103(a) as obvious over

Bezos et al in view of Hudson et al (4,650,987).

As per Claim 13, 20.
Bezos et al further discloses electronically charging a fee to said first party, see figure 4 (405, 406).
Hudson et al teaches charging a fee for a transaction, see column 7, lines 54-65 for the benefit of providing convenience to the customer in receiving money at convenient times
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 14.
Bezos et al further discloses electronically charging a fee to said first party, see figure 4 (405, 406).
Bezos et al does not disclose electronically charging a fee to a charge card.
Hudson et al teaches charging a fee for a transaction, see column 7, lines 54-65 for the benefit of providing convenience to the customer in receiving money at convenient times
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 16.
Bezos et al does not disclose electronically charging a fee to said first party, see figure 4 (405, 406).

Hudson et al teaches charging a fee for a transaction, see column 7, lines 54-65 for the benefit of providing convenience to the customer in receiving money at convenient times

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 17.

Bezos et al further discloses electronically charging second fee related to the value of the gift, see figure 4 (405, 406).

Hudson et al teaches charging a fee for a transaction, see column 7, lines 54-65 for the benefit of providing convenience to the customer in receiving money at convenient times

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 18.

Bezos et al does not disclose electronically charging a fee, see figure (405,406).

Hudson et al teaches charging a fee for a transaction, see column 7, lines 54-65 for the benefit of providing convenience to the customer in receiving money at convenient times

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

11. Claims 11, 26-28 is rejected under 35 U.S.C. 103(a) as obvious over Bezos et al in view of Wolf (5,219,184).

As per Claims 11, 28.

Bezos et al does not disclose giving the gift giver the opportunity to reveal true identity information.

Wolf ('184) teaches enabling gift senders to reveal their true identity information, see abstract and figure 6, as a matter of convenience of reply.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention to reply to reveal the giver's true identity to the recipient as a matter of convenience of reply.

As per Claim 26.

Bezos et al further discloses the use of email addresses for sending gifts, see paragraph (0016).

Bezos et al does not disclose enabling said second parties to respond to said first party after receipt of said gift.

Wolf ('184) teaches enabling gift recipients to send thank you notes to the sender upon receipt of a gift, see abstract and figure 6, as a matter of courtesy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention to reply to an email to send a thank you note to the sender upon receipt of a gift as a matter of courtesy.

As per Claim 27.

Bezos et al further discloses the use of email addresses for sending gifts, see paragraph (0016).

Bezos et al does not disclose enabling said second parties to respond to said first party after refusal of said gift.

Wolf ('184) teaches enabling gift recipients to send thank you notes to the sender upon receipt of a gift, see abstract and figure 6, it is further known to say "no thank you" upon declining a gift as a matter of courtesy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention to reply to an email to send a note to the sender upon declining of a gift as a matter of courtesy.

Allowable Subject Matter

12. Claims 9, 12, 15, 21-25, 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

As per Claims 9.

Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach electronically informing the first party that the second party has not chosen to accept gift addressed only by said second party's pseudonym.

As per Claims 12.

Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach electronically giving the gift recipient the opportunity to reveal true identity information.

As per Claims 15.

Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach electronically confirming receipt of said order that said gift be sent before charging said fee to said first party.

As per Claims 21.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach giving the gift recipient the opportunity to refuse a gift.

As per Claims 22.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach giving the gift recipient the opportunity to refuse a gift if the first party is identified only by a pseudonym.

As per Claims 23.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach giving the gift recipient the opportunity to refuse a gift if the giver is not identified by a true name.

As per Claims 24.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach giving the gift recipient the opportunity to refuse a gift if the giver is identified by a particular true name.

As per Claims 25.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach giving the gift recipient the opportunity to refuse a gift if the gift is of a particular product-type.

As per Claim 30.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach the gift is sent responsive to a message from the second party.

As per Claim 31.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach the gift is sent responsive to an acceptance communication from the second party.

As per Claim 32.
Bezos et al in view of Barron et al or Hudson et al or Wolf does not disclose or fairly teach the gift is sent only responsive to an acceptance communication from the second party.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Thomas A. Dixon
Examiner
Art Unit 3629

January 27, 2003